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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of
Vivian A. Schramm
Michael R. Schramm

Serial No.: 09/707,156

Filed: November 06, 2000

For: Spill-Proof Candy Container

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Group Art Unit: 1761

Examiner: Steven L.
Weinstein

APPEAL BRIEF

Commissioner of Patents
and Trademarks
Washington, D.C. 20231

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Michael R. Schramm	September 23, 2005
Applicant	Date
<i>Michael R. Schramm</i>	
Signature	

Dear Sir:

Pursuant to 37 C.F.R. 1.192, Appellants submit this Appeal Brief in triplicate to the Board of Patent Appeals and Interferences in support of their appeal from the decision dated June 9, 2005 of the Examiner rejecting claims 1-14 and 21-25 of the captioned application and in response the official office action dated June 9, 2005. Appellants note that an appeal brief fee was submitted with Appellants original appeal brief on February 24, 2004. Appellants respectfully request that this previously transmitted fee be accepted for the current appeal brief fee and if for some reason such previously paid fee is unacceptable or insufficient, appellants respectfully request that any remaining fee be charged to the credit card which was used to pay appellants previous fee. Appellants submit that the Examiner erred in rejecting the claims, and respectfully request reversal of the rejection.

(1) **Real Party in Interest**

The real party in interest is Vivian A. Schramm and Michael R. Schramm.

(2) **Related Appeals and Interferences**

Appellants are unaware of any pending appeal or interference which affects this appeal.

(3) **Status of Claims**

Claims 1-14 and 21-25 are pending and on appeal. Claims 15-20 have been cancelled.

(4) **Status of Amendments**

The appealed claims have been finally rejected. Only claim 4 has been amended subsequent to the final rejection of the claims. This amendment was made for the express purpose of adding an antecedent to support the words "said lollipop" according to the examiner's rejection.

(5) **Summary of Invention**

The present invention is a self-contained spill-resistant container of an edible particulate matter having a lollipop type candy which is removably contained within the container as identified by feature number 10 in drawing figures 1 through 3 and as summarized in the specification on page 4 lines 13 through 24. The invention has particular application for ease of use by young children in consuming particulate candy combined with a lollipop type candy without the normal mess and spills typically associated with the consumption of such candy by children.

(6) **Issues**

The issues on appeal are 1) whether or not claims 1-14 contain new matter under 35 USC § 112, first paragraph, 2) whether or not the examiner has properly rejected the appealed claims based on obvious-type double patenting of claims 1-9 of US patent 5,246,046 and of claims 1-11 of US patent RE36,131 in view of Hunter (GB '356), Matindale ('797), Coleman ('884), and Hoeting et al ('870), 3) whether or not the examiner has properly rejected the appealed claims based on obvious-type double patenting of claims 1-29 of US patent 6,386,138 in view of Hunter (GB '356), Matindale ('797), Coleman ('884), and Hoeting et al ('870), 4) whether or not the examiner has properly rejected the appealed claims based on obviousness under 35 USC § 103(a) based on Hunter (GB '356) in view of

Schramm ('046), Martindale ('797), and Coleman ('884)/Hoeting et al ('870) and in view of Kennedy ('390), Beutlich et al (GB '581), McCombs ('714), Meth ('599), and Patterson ('975), and 5) whether or not the examiner has properly rejected the appealed claims under 35 USC § 102(e)/103 in view of Hunter (GB '356), Schramm ('138), Martindale ('797), and Coleman ('884)/Hoeting et al ('870) and in further view of Kennedy ('390), Beutlich et al (GB '581), McCombs ('714), Meth ('599), and Patterson ('975).

(7) Grouping of Claims

The groups of claims 1-7, 8-14, and 21-25 should be separately considered. Claims 1-7 stand or fall together, claims 8-14 stand or fall together, and claims 21-25 stand or fall together. The three groups of claims do not stand or fall together. Appellants respectfully point out that the group of claims 1-7 is separately patentable from the groups of claims 8-14 or 21-25 due to the different subject matter claimed in each group of claims. Specifically, the claims of group 1-7 are drawn to a container having a predetermined shape and containing predetermined contents. Whereas the claims of group 8-14 are drawn to a container having not only a predetermined shape and containing predetermined contents, but also being limited to being spill resistant. Further, the claims of group 21-25 are drawn to a container of having not only a predetermined shape, but also being limited to containing an edible fluent non-gaseous substance and a solid confectionery material. Due to these patentably distinct limitations, each group of claims is seen as being separately patentable and each group of claims is seen as standing or falling separately.

(8.1) Argument 1, Claims 1-14 were erroneously rejected as containing new matter:

Appellants respectfully traverse the Examiners argument that Appellant's application contains new matter. The examiner argues that the use of the phrase "edible flowable candy substance" constitutes new matter and further that "the sole disclosure of candy material in the container is the lollipop or the solid particulate material". Appellants respectfully point out the original specification specifically stated, "Edible particulate matter 60 defines a free flowing edible particulate matter such as flavored candy powder, candy beads, or any other particulate type edible material" (see page 6, first paragraph, last sentence). Appellants further respectfully point out such description, which describes a substance that is edible and exhibits the property of flow, clearly provides support for the claimed "edible flowable candy substance".

Additionally, the examiner argues that, “The phrase edible “flowable” candy substance is readable on liquids, which are not disclosed as originally filed.” Appellants respectfully urge that to the extent that support for claim language is found in the originally filed specification (e.g. candy powder in support of “edible flowable candy substance”), that the claim language may also read on other things (e.g. liquids) is of no consequence and does not constitute new matter.

The following is a quotation of 35 USC § 112, first paragraph:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The appellants respectfully maintain that inasmuch as a “free flowing edible particulate matter such as flavored candy powder” was disclosed in the original specification, with respect to an “edible flowable candy substance”, the written description requirement of 35 USC § 112, first paragraph is satisfied. Thus even though an “edible flowable candy substance” may read on a liquid, such reading on a liquid does not negate the satisfaction of 35 USC § 112, first paragraph’s written description requirement. If on the other hand, the appellants had claimed matter that was not supported in the original specification, such as for instance by “adding specific percentages or compounds after a broader original disclosure” or by “the omission of a step from a method”, the appellants would agree that new matter was added.

Thus by reading 35 USC § 112, first paragraph, the appellants urge that the test to determine new matter is not “Can the claims read on matter not disclosed in the specification?” as the examiner implies but rather “Are the claims supported by the original specification?”. The appellants argue that if the appellant’s original specification can support the phrase in question, then the claimed subject matter cannot be construed to be new matter. The appellants offer the following comparison as an example in support of their position. If for instance an applicant disclosed an automotive vehicle having red colored tires, ignoring any issues of novelty and obviousness, etc., the appellants argue that the applicant should be entitled to claim “a vehicle having non-black colored tires”. Conversely, by the reasoning established in the examiner’s rejection, the applicant would not be able to make the noted claim as “a vehicle having non-black colored tires” would read on a vehicle having blue (or other non-

black) colored tires when only red colored tires were disclosed. Again, appellants disagree with the latter argument. In as much as it is established that the original specification supports the claimed subject matter, it is urged that a “new matter” rejection is not proper and it is requested that the rejection be reversed.

(8.2) Argument 2, Claims 1-14 and 21-25 were erroneously rejected under Obvious Type Double Patenting:

The examiner has rejected claims 1 – 14 and 21 – 25 under obvious type double patenting over claims 1 – 9 of US patent 5,246,046 and claims 1 – 11 of US patent RE36,131 in view of Hunter (GB ‘356), Martindale (‘797), Coleman (‘884) and Hoeting et al (‘870). Appellants respectfully traverse the examiner’s rejection on the basis that the appellant’s invention in the appended claims is substantially different than the claims of the cited prior patents of the appellant and on the basis of negative teaching.

Substantially Different: Appellants urge that the teachings of ‘046 and ‘131 are far removed from that of the claims of the current application. Appellants note that ‘046 and ‘131 were directed toward resisting the spillage of liquid bubble solution whereas appellant’s current application is directed towards resisting the spillage of candy powder, candy beads, or other flowable candy substance while having an open container access so as to be able to coat a lollipop type confection with the candy substance. The successful creation of a product that allows the user to readily coat a lollipop type confection with candy powder or the like without having the burden of opening and closing a lid or other perform some other cumbersome process creates a heretofore unknown and nonobvious product. Thus the difference between the prior patents and the current application is greater than merely a recitation that the container now contains edible matter.

Negative Teaching: As noted in the appellants office action responses, both Coleman and Hoeting recognized the problem of spillage of candy particulate and both attempt to address the problem in their respective inventions. It is also acknowledged that Coleman does provide a candy particulate container having a degree of spill resistivity. However, in as much as Coleman stores the lollipop product outside of the particulate containing compartment of the container, the container must

be opened to access the particulate with the lollipop. By opening the Coleman container, the container is then of course, rendered highly spillable much like any open-mouthed conventional container.

In an apparent effort to overcome this loss of spill resistivity, Hoeting redesigned his disclosed invention to place both the lollipop product and the particulate candy within the same “spill resistant” closed container. And as with Coleman, so long as the Hoeting container remains closed, the Hoeting container is spill resistant. And as with Coleman, in order to use the Hoeting container, the Hoeting container must be opened, rendering Hoeting highly spillable. However, in spite of having access to Hunter and Martindale, not only have Coleman and Hoeting put forth edible particulate containers lacking the very funnel that could have solved the recognized problem, Hoeting introduced a new problem. The Hoeting product is analogous to an unassuming person holding a conventional cup of coffee and wearing a wristwatch. When the person is asked “what time is it?” the person responds by turning his wrist to observe the face of his watch, only to spill his coffee from his cup. Likewise, because Hoeting placed the lollipop inside of the container with the candy particulate, it is a natural tendency for a user of the Hoeting product to spill the candy particulate when rotating the Hoeting container into a position to access the lollipop. In summary, Coleman and Hoeting, in spite of Hunter, Martindale, and all other prior art, have taught inventions that do not solve their own recognized problem of spill resistance of accessible particulate candy. Appellants suggest that if their invention was obvious to one having ordinary skill in the art, then inventors such as Coleman and Hoeting who had access to art having containers with funnels, would have solved the problem as appellants have done. Instead, in spite of the long felt need, other inventors such as Coleman and Hoeting have not invented the applicant’s invention and Coleman and Hoeting have negatively taught spill resistance of particulate candy with convention non-funneled containers that are in fact highly spillable.

In conclusion, appellants suggest that the spill resistant candy container is no more obvious in light of powder containers having funnels and candy powder containers than appellant’s spill resistant bubble solution container was in light of bubble solution containers with a version of a funnel and spill resistant liquid containers (e.g. appellant’s ‘046 and ‘131 patents were allowed over such noted prior art). Given the substantially different invention and the negative teaching, it is urged that a double patenting rejection is not proper and it is requested that the examiner be reversed.

(8.3) Argument 3, Claims 1-14 and 21-25 were erroneously rejected under Obvious Type Double Patenting:

The examiner has rejected claims 1 – 14 and 21 – 25 under obvious type double patenting over claims 1–29 of US patent 6,386,138 in view of Hunter (GB ‘356), Martindale (‘797), Coleman (‘884) and Hoeting et al (‘870). Appellants respectfully traverse the examiner’s rejection on the basis that the appellant’s invention in the appended claims is substantially different than the claims of the cited prior patent of the appellant and on the basis of negative teaching.

Substantially Different: Appellants urge that the teaching of ‘138 is far removed from that of the amended claims of the current application. Appellants note that ‘138 was directed toward resisting the spillage of a liquid dye while coloring an Easter egg whereas appellants current application is directed towards resisting the spillage of candy powder, candy beads, or other flowable candy substance while having an open container access so as to be able to coat a lollipop type confection with the candy substance. The successful creation of a product that allows the user to readily coat a lollipop type confection with candy powder or the like without having the burden of opening and closing a lid or other performing some other cumbersome process creates a heretofore unknown and nonobvious product. Thus the difference between the prior patents and the current application is greater than merely a recitation that the container now contains a different work piece.

Negative Teaching: As noted in the appellants office action responses, both Coleman and Hoeting recognized the problem of spillage of candy particulate and both attempt to address the problem in their respective inventions. It is also acknowledged that Coleman does provide a candy particulate container having a degree of spill resistivity. However, in as much as Coleman stores the lollipop product outside of the particulate containing compartment of the container, the container must be opened to access the particulate with the lollipop. By opening the Coleman container, the container is then of course, rendered highly spillable much like any open-mouthed conventional container.

In an apparent effort to overcome this loss of spill resistivity, Hoeting redesigned his disclosed invention to place both the lollipop product and the particulate candy within the same “spill resistant” closed container. And as with Coleman, so long as the Hoeting container remains closed, the Hoeting container is spill resistant. And as with Coleman, in order to use the Hoeting container, the Hoeting container must be opened, rendering Hoeting highly spillable. However, in spite of having access to

Hunter and Martindale, not only have Coleman and Hoeting put forth edible particulate containers lacking the very funnel that could have solved the recognized problem, Hoeting introduced a new problem. The Hoeting product is analogous to an unassuming person holding a conventional cup of coffee and wearing a wristwatch. When the person is asked “what time is it?” the person responds by turning his wrist to observe the face of his watch, only to spill his coffee from his cup. Likewise, because Hoeting placed the lollipop inside of the container with the candy particulate, it is a natural tendency for a user of the Hoeting product to spill the candy particulate when rotating the Hoeting container into a position to access the lollipop. In summary, Coleman and Hoeting, in spite of Hunter, Martindale, and all other prior art, have taught inventions that do not solve their own recognized problem of spill resistance of accessible particulate candy. Appellants suggest that if their invention was obvious to one having ordinary skill in the art, then inventors such as Coleman and Hoeting who had access to art having containers with funnels, would have solved the problem as appellants have done. Instead, in spite of the long felt need, other inventors such as Coleman and Hoeting have not invented the applicant’s invention and Coleman and Hoeting have negatively taught spill resistance of particulate candy with convention non-funneled containers that are in fact highly spillable.

In conclusion, appellants suggest that the spill resistant candy container is no more obvious in light of powder containers having funnels and candy powder containers than appellant’s spill resistant bubble solution container was in light of bubble solution containers with a version of a funnel and spill resistant liquid containers (e.g. appellant’s ‘046 and ‘131 patents were allowed over such noted prior art). Given the substantially different invention and the negative teaching, it is urged that a double patenting rejection is not proper and it is requested that the examiner be reversed.

(8.4) Argument 4, Claims 1-14 and 21-25 were erroneously rejected as obvious:

The examiner has rejected claims 1 – 14 and 21 – 25 under 35 USC § 103(a) based on Hunter (GB ‘356) in view of Schramm (‘046), Martindale (‘797), and Coleman (‘884)/Hoeting et al (‘870) and in view of Kennedy (‘390), Beutlich et al (GB ‘581), McCombs (‘714), Meth (‘599), and Patterson (‘975). Appellants respectfully traverse the examiner’s rejection on the basis that the appellant’s invention in the appended claims is substantially different than the cited prior patents and on the basis of negative teachings by the cited patents.

Substantially Different: Appellants urge that the teachings of Hunter (GB '356) are far removed from that of the claims of the current application. Appellants note that Hunter (GB '356) is directed toward a generic spill resistant container for fluent materials whereas appellants current application is directed towards resisting the spillage of candy powder, candy beads, or like flowable candy substance while having an open container access so as to be able to coat a lollipop type confection with the candy powder or candy beads. The successful creation of a product that allows the user to readily coat a lollipop type confection with candy powder or the like without having the burden of opening and closing a lid or other perform some other cumbersome process creates a heretofore unknown and nonobvious product. While the other referenced patents teach additional features beyond Hunter (GB '356), none of the cited patents alone or in combination teach toward the spill resistant candy container disclosed by appellants. Thus the difference between the prior patents and the current application is greater than merely a recitation that the container now contains edible matter. The examiner states that, "the differences are substantially in the content of the container". The appellants agree that there are substantial differences in the contents of the current inventive container and the containers of the previous inventions. Appellants urge that such difference in container contents contributes to the patentability of the subject invention. While the examiner may not perceive the container contents as contributing to patentability and non-obviousness, clearly, this is not a position universally held by the office. To confirm this, one need look no further than appellants own cited prior invention. US patent 6,386,138, which is directed to a spill proof Easter egg coloring container was allowed in part due to the unique matter contained within the container (e.g. an egg shaped edible article). See for instance independent claims 10 and 20.

Negative Teaching: Appellants respectfully disagree with the examiner and urge that the Coleman and Hoeting art provide negative teachings. Appellants respectfully suggest that the negative teaches needn't be limited to what is claimed but may be found elsewhere in the specification. As noted in the appellants office action responses, both Coleman and Hoeting recognized the problem of spillage of candy particulate and both attempt to address the problem in their respective inventions. It is also acknowledged that Coleman does provide a candy particulate container having a degree of spill resistivity. However, in as much as Coleman stores the lollipop product outside of the particulate containing compartment of the container, the container must be opened to access the particulate with

the lollipop. By opening the Coleman container, the container is then of course rendered highly spillable much like any open-mouthed conventional container.

In an apparent effort to overcome this loss of spill resistivity, Hoeting redesigned his disclosed invention to place both the lollipop product and the particulate candy within the same “spill resistant” closed container. And as with Coleman, so long as the Hoeting container remains closed, the Hoeting container is spill resistant. And as with Coleman, in order to use the Hoeting container, the Hoeting container must be opened, rendering Hoeting highly spillable. However, in spite of having access to Hunter and Martindale, not only have Coleman and Hoeting put forth edible particulate containers lacking the very funnel that could have solved the recognized problem, Hoeting introduced a new problem. The Hoeting product is analogous to an unassuming person holding a convention cup of coffee and wearing a wristwatch. When the person is asked “what time is it?” the person responds by turning his wrist to observe the face of his watch, only to spill his coffee from his cup. Likewise, because Hoeting placed the lollipop inside of the container with the candy particulate, it is a natural tendency for a user of the Hoeting product to spill the candy particulate when rotating the Hoeting container into a position to access the lollipop. In summary, Coleman and Hoeting, in spite of Hunter, Martindale, and all other prior art, have taught inventions that do not solve their own recognized problem of spill resistance of accessible particulate candy. Appellants suggest that if their invention was obvious to one having ordinary skill in the art, then inventors such as Coleman and Hoeting who had access to art having containers with funnels, would have solved the problem as the applicants have done. Instead, in spite of the long felt need, other inventors such as Coleman and Hoeting have not invented the appellant’s invention and Coleman and Hoeting have negatively taught spill resistance of particulate candy with convention non-funneled containers that are in fact highly spillable.

In conclusion, appellants suggest that the spill resistant candy container is no more obvious in light of powder containers having funnels and candy powder containers than appellant’s spill resistant bubble solution container was in light of bubble solution containers with a version of a funnel and spill resistant liquid containers (e.g. appellant’s ‘046 and ‘131 patents were allowed over such noted prior art). Given the substantially different invention and the negative teaching, it is urged that an obvious type rejection is not proper and it is requested that the examiner be reversed.

(8.5) Argument 5, Claims 1-14 and 21-25 were erroneously rejected under 35 USC 102(e)/103:

The examiner has rejected claims 1 – 14 and 21 – 25 under 35 USC § 102(e)/103 in view of Hunter (GB ‘356), Schramm (‘138), Martindale (‘797), and Coleman (‘884)/Hoeting et al (‘870) and in further view of Kennedy (‘390), Beutlich et al (GB ‘581), McCombs (‘714), Meth (‘599), and Patterson (‘975). Appellants respectfully traverse the examiner’s rejection essentially for the reasons given above – i.e. on the basis that the appellant’s invention in the appended claims is substantially different than the cited prior patents and on the basis of negative teachings by the cited patents.

In all of the claims of the current application, appellants have limited their claims to having candy containers. The majority of the cited prior art are far removed from the appellants current invention and do not remotely address candy or candy containers. Those prior patents that do deal with candy containers have been shown to teach contrary to appellants invention in spite of the available prior art and have been shown to be lacking a sustentative spill resistant function (when the container is opened). Given the substantially different invention and the negative teaching, it is urged that the 35 USC § 102(e)/103 rejection is not proper and it is requested that the examiner be reversed.

(9) **Appendix**

The following are the claims involved with this appeal.

1. A container for inhibiting the spillage of contents of said container, wherein said container defines an inner cavity and a funnel extending into said inner cavity to provide communication between said inner cavity and the exterior of said container, and wherein said container removably contains at least one substance of the following group of substances comprising an edible particulate candy substance, an edible flowable candy substance, and a candy article substance.
2. The container of claim 1 wherein said edible particulate substance further defines at least one substance of the following group of substances comprising a candy powder substance and a candy bead substance, and wherein said candy article substance further defines a substance of one of the following group of substances comprising a discreet substantially spherical candy substance and a lollipop substance.
3. The container of claim 1 wherein said container inhibits the spillage of said substance when said container is oriented in any position.
4. The container of claim 3 wherein said container includes a lollipop within said container and wherein said lollipop is removable from said container by passing said lollipop through said funnel.
5. The container of claim 2 wherein said lollipop defines a lollipop having a handle and wherein said handle includes a pliable holder mounted to said handle and wherein said holder is sealingly engagable to said container.
6. The container of claim 1 wherein said funnel includes an inner opening and wherein said inner opening is located near the center of said container.
7. The container of claim 1 wherein at least a portion of said container is substantially transparent so as to reveal the contents of said container.

8. A container for inhibiting the spillage of contents of said container, wherein said container defines an inner cavity and an open opening in a wall of said container to provide communication between said inner cavity and the exterior of said container and wherein said container inhibits the spillage of free flowing particulate matter when said container contains free flowing particulate matter and is oriented in any position and wherein said container contains at least one substance of the following group of substances comprising an edible particulate candy substance, an edible flowable candy substance, and a candy article substance.
9. The container of claim 8 wherein said edible particulate substance further defines at least one substance of the following group of substances comprising a candy powder substance and a candy bead substance, and wherein said candy article substance further defines a substance of one of the following group of substances comprising a discreet substantially spherical candy substance and a lollipop substance.
10. The container of claim 8 wherein said open opening defines an open funnel.
11. The container of claim 10 wherein said lollipop is removable from said container by passing said lollipop through said funnel.
12. The container of claim 9 wherein said lollipop substance defines a lollipop having a handle and wherein said handle includes a pliable holder mounted to said handle and wherein said holder is sealingly engagable to said container.
13. The container of claim 10 wherein said funnel includes an inner opening and wherein said inner opening is located near the center of said container.
14. The container of claim 8 wherein at least a portion of said container is substantially transparent so as to reveal the contents of said container.
21. A container for inhibiting the spillage of contents of said container, wherein said container defines an inner cavity and a funnel extending into said inner cavity to provide communication between said inner cavity and the exterior of said container, and

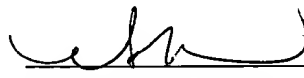
wherein said container contains an edible particulate candy substance and wherein said container removably contains a candy article.

22. The container of claim 21 wherein said particulate candy substance further defines a substance of one of the following group of substances comprising a candy granular substance, a candy powder substance, and a candy bead substance.
23. The container of claim 21 wherein said container inhibits the spillage of said substance when said container is oriented in any position.
24. The container of claim 21 wherein said funnel includes an inner opening and wherein said inner opening is located near the center of said container.
25. The container of claim 21 wherein said candy article further defines a lollipop having an edible candy portion and a handle portion.

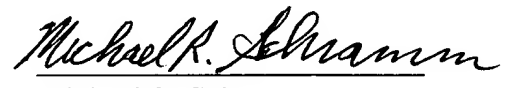
(10) **Conclusion**

In view of the comments above, it is submitted that the Examiner erred in rejecting the claims on appeal. Appellants therefore respectfully request that this Honorable Board reverse the Examiner's rejection of the claims. If the Board has any questions or comments which may be resolved over the telephone, the board is requested to call Michael R. Schramm at 801-625-9268 (wk) or at 435-734-2599 (hm).

DATE: September 23, 2005 Respectfully submitted,



Vivian A. Schramm



Michael R. Schramm

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